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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 09/698,502
Filing Date: October 27, 2000
Appellant(s): MENENDEZ ET AL.

Benjamin L. Volk, Jr. (Reg. No. 48,017)
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 16 April 2012 appealing from the Office
action mailed 17 March 2011.

(1) Real Party in Interest

The examiner has no comment on the statement, or lack of statement, identifying by name the real party in interest in the brief.

(2) Related Appeals and Interferences

The following are the related appeals, interferences, and judicial proceedings known to the examiner which may be related to, directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

This patent application was the subject of a previous appeal to the Board of Patent Appeals and Interferences (BPAI) (Appeal 2007-3067), said appeal resulting in a Decision on Appeal dated February 20, 2008 (copy referenced in the Related Proceedings Appendix and enclosed as Exhibit 9).

This patent application is related to patent application serial numbers 09/556,153, 09/564,911, 09/698,491, 09/698,552, 12/650,040, and 12/650,113. The 09/556,153 and 09/564,911 patent applications are abandoned. The 09/698,491 patent application and the 09/698,552 patent application were previously the subject of appeals to the BPAI (Appeals 2009-0121 and 2008-1057 respectively), although Requests for Continued Examination (RCEs) were filed prior to any Decision on Appeal in those patent applications. The 09/698,491 patent application has since become abandoned while the 09/698,552 patent application is still pending. The 12/650,040 patent application and the 12/650,113 patent application are also still pending

(3) Status of Claims

The following is a list of claims that are rejected and pending in the application:

62 – 78, 113 – 127, 137 and 139.

(4) Status of Amendments After Final

The examiner has no comment on the appellant's statement of the status of amendments after final rejection contained in the brief.

(5) Summary of Claimed Subject Matter

The examiner has no comment on the summary of claimed subject matter contained in the brief.

(6) Grounds of Rejection to be Reviewed on Appeal

The examiner has no comment on the appellant's statement of the grounds of rejection to be reviewed on appeal. Every ground of rejection set forth in the Office action from which the appeal is taken (as modified by any advisory actions) is being maintained by the examiner except for the grounds of rejection (if any) listed under the subheading "WITHDRAWN REJECTIONS." New grounds of rejection (if any) are provided under the subheading "NEW GROUNDS OF REJECTION."

(7) Claims Appendix

The examiner has no comment on the copy of the appealed claims contained in the Appendix to the appellant's brief.

(8) Evidence Relied Upon

5,389,773

COUTTS et al.

02-1995

- Hertz Announces New, Elite Levels for #1 Club Gold Members in the US, 11 July 2000, PR Newswire Association, Inc.
- Information on Hertz Corporation, 1997 - 2000, archived web pages printed through www.archive.org, data is in the URL in YYYYMMDD Format
- Information on Avis Rent A Car, Inc., 02 March 2000

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 62 – 78, 113 – 127 and 136, and 139 are not patentable under 35 U.S.C. 112, second paragraph, because invention as currently claimed is vague to

determine scope of subject matter which applicant regards as the invention. Applicant added the limitation "wherein the electronically accepting, communicating, electronic rental contract creating and rental transaction are performed of whether the user has a pre-existing master rental agreement with a rental car company that operates the rental car facility. It is known to one of ordinary skill in the art, rental car company has franchised their facilities, and, each franchisor can have their own rental agreement with local businesses. As currently claimed, it is not clear which pre-existing rental agreement (franchisee or rental car company) will be considered for generating a contract.

In addition, it not clear whether the rental contract is created in the same session when the rental proposal is accepted by the applicant, because claimed invention in dependent claims solicits for additional information from the customer, As it is old and known that contract cannot be changed, but amended, there is a confusion whether the contract as claimed by the applicant is a contract or something else.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 62 – 66, 71 – 78, 113 – 116, 121 – 127 and 128 – 135 are not patentable under 35 U.S.C. 103(a) over Hertz Corporation hereinafter known as Hertz in view of Avis Rent A Car System, Inc. hereinafter known as Avis and Hertz Announces New, Elite Levels for #1 Club Gold Members in the US – Revamps its #1 Club Membership with Free Upgrade to #1 Club Gold Service hereinafter known as HertzGold.

Regarding claims 62 and 113, Hertz teaches system and method for online rental vehicle reservation. Hertz teaches that that now you (user) can check the latest Hertz rates and instantly make, modify (user can retrieve previously stored reservation to make modification), or, cancel (user can retrieve previously stored reservation to cancel) reservation on-line [page 17]. Hertz does not explicitly recite storing the electronic rental agreement based upon said accepted rental proposal. However, Hertz discloses that customers can modify or cancel reservations [pages 17]. **This clearly shows that Hertz may have some sort of storing capability to be able to allow their clients to retrieve the reservation information.** Avis discloses storing rental information. Avis disclose to retrieve rental information base upon the reservation number [page 13].

Therefore, at the time of invention, it would have been obvious to one of ordinary skill in the art to modify Hertz by adopting teachings of Avis to be able to allow customers to retrieve their rental information at a later time; apply a known technique to a known device (method, or product) ready for improvement to yield predictable results;

known work in one field of endeavor may prompt variations of it for use in either the same field or a different one based on design incentives or other market forces if the variations would have been predictable to one of ordinary skill in the art

Hertz in view of Avis does not explicitly recite creating a rental contract for a rental vehicle in response to an electronic acceptance by the user of the electronic rental proposal. However, HertzGold teaches concept and capability wherein HertzGold customers do not have to go to any counters. They can proceed straight to there pre-selected vehicle. **This clearly shows that HertzGold generates contract for their customers when a reservation is made to enable them to bypass the rental counter.**

Therefore, at the time of invention, it would have been obvious to one of ordinary skill in the art to modify Hertz in view of Avis by adopting teachings of HertzGold be enable their customers to bypass visit at the rental counter thereby saving them time; apply a known technique to a known device (method, or product) ready for improvement to yield predictable results; known work in one field of endeavor may prompt variations of it for use in either the same field or a different one based on design incentives or other market forces if the variations would have been predictable to one of ordinary skill in the art

Hertz in view of Avis and HertzGold teaches capability for:

creating and storing an electronic rental contract for a rental vehicle such that a user need not visit a rental counter to create a rental contract when arriving at a car rental facility to pick up the rental vehicle:

hosting a website on a server system, the website comprising a plurality of web pages for access over a network by any of a plurality of client systems [www.Hertz.com];

creating a rental vehicle reservation in response to data received through the website from a client system [Hertz, page 67 – 68];

storing a reservation transaction within the server system, wherein the reservation transaction is representative of the created rental vehicle reservation [Avis, page 13];

electronically accepting additional data from a user through the website for a potential rental of a rental vehicle based on the rental vehicle reservation [Hertz, page 67 – 68];

communicating an electronic rental proposal for display to the user on a web page of the website, the electronic rental proposal being based on the rental vehicle reservation and the accepted additional data [Hertz, page 67 – 68];

creating an electronic rental contract for a rental vehicle in response to an electronic acceptance by the user of the electronic rental proposal, the electronic rental contract permitting the user to avoid creating a rental contract at the rental counter when arriving at the car rental facility to pick up a rental vehicle in accordance with the electronic rental contract [HertzGold]; and

storing a rental transaction within the server system, wherein the rental transaction is representative of the created electronic rental contract [Avis, HertzGold];

wherein the electronically accepting, communicating, electronic rental contract creating and rental transaction storing steps are performed regardless of whether the user has a pre-existing master rental agreement with the rental car company that operates the rental facility (i.e. **user may or may not have a Master Rental Agreement**) [HertzGold]

Regarding claim 63, Hertz in view of Avis and HertzGold teaches capability for allocating a rental vehicle to the user at the car rental facility in accordance with the electronic rental contract without requiring the user to visit the rental counter [HertzGold].

Regarding claims 64 and 114, Hertz in view of Avis and HertzGold teaches capability for:

after the reservation creating step, electronically receiving input from the user indicative of a request to convert the created reservation into an electronic rental contract [HertzGold]; and

responsive to the received input, providing a web page of the website to a client system for display thereon that is configured to solicit the additional data from the user (Hertz, Avis teach capability wherein customers can modify their rental information).

Regarding claims 65 and 115, Hertz in view of Avis and HertzGold teaches capability for:

after the reservation creating step, providing a web page of the website to the client system for display thereon that is configured to provide the user with a user-selectable option to only create the reservation and a user-selectable option to convert the created reservation into an electronic rental contract (**Hertz and Avis teaches providing web pages to users with plurality of selectable buttons for indication their selection. One of ordinary skill in the art can add create contract button on the web page displayed to the user**); and

receiving a user selection of the option to convert the created reservation into an electronic rental contract, thereby advancing the user to the web page that is configured to solicit the additional data from the user [**HertzGold, teaches of some contract between customer and HertzGold to enable the customer to bypass rental counter**].

Regarding claims 66 and 116, Hertz in view of Avis and HertzGold teaches capability for:

after the reservation creating step, sending an email to the user, wherein content of the email can comprise:

- (1) a confirmation of the created reservation, and
- (2) a user-selectable link that is effective upon user selection to link the user to the web page which can be configured to solicit the additional data from the user;

wherein the input receiving step capability and concept can comprise receiving a user selection of the link (**sending confirmation emails to customer with active links**

is old and known technique known to one of ordinary skill in the art at the time of reservation).

Regarding claims 71 and 121, Hertz in view of Avis and HertzGold teaches capability for a user who has a pre-existing master rental agreement with the rental car company, providing a web page of the website to a client system for display thereon that is configured to solicit the data for creating the reservation from the user, and automatically pre-filling at least a portion of the data for creating the reservation into that web page from the master rental agreement [Hertz teaches capability for using information from Master Agreement and user profile for reservation].

Regarding claims 72 and 122, Hertz in view of Avis and HertzGold teaches capability for permitting the user to electronically modify the pre-filled data without modifying the master rental agreement.

Regarding claims 73 and 123, Hertz in view of Avis and HertzGold teaches capability for:

receiving a modification of the pre-filled data from the user through the website;
and
electronically notifying the user with a selectable option to keep the modification and a selectable option to revert to the pre-filled data
receiving a selection of one of the two options from the user; and

using the data for the reservation based on the received option selection.

Regarding claims 74 and 124, Hertz in view of Avis and HertzGold teaches capability wherein the additional data can be driver's license information for the user, and capability for performing the following steps before the communication step:

electronically performing a validation operation on the driver's license information such that the communicating step is not performed should the validation operation indicate the driver's license information is invalid (HertzGold and Hertz teaches concept for validating customers); and

should the validation operation indicate the driver's license information is invalid, electronically requesting that the user re-submit new driver's license information.

Regarding claims 75 and 125, Hertz in view of Avis and HertzGold teaches capability wherein the additional data can be credit card payment information for the user, capability for performing the following steps before the communication step:

electronically performing a validation operation on the credit card payment information such that the communicating step is not performed should the validation operation indicate the credit card payment information is invalid (**validating credit card prior to confirming an order is old and known to one of ordinary skill in the art**); and

should the validation operation indicate the credit card payment information is invalid, electronically requesting that the user re-submit new credit card payment information.

Regarding claims 76 and 126, as responded to earlier, Hertz in view of Avis and HertzGold teaches capability for wherein the additional data can be driver's license information for the user and credit card payment information for the user, and capability for performing the following steps before the communication step:

electronically performing a first validation operation on the driver's license information such that the communicating step is not performed should the first validation operation indicate the driver's license information is invalid;

should the first validation operation indicate the driver's license information is invalid, electronically requesting that the user re-submit new driver's license information;

electronically performing a second validation operation on the credit card payment information such that the communicating step is not performed should the second validation operation indicate the credit card payment information is invalid; and

should the second validation operation indicate the credit card payment information is invalid, electronically requesting that the user re-submit new credit card payment information.

Regarding claims 77, Hertz in view of Avis and HertzGold teaches capability wherein the server system can be operated by the rental car company.

Regarding claims 78 and 127, Hertz in view of Avis and HertzGold teaches capability wherein the additional data can be a modification of a the reservation data.

Regarding claims 138, Hertz in view of Avis and HertzGold teaches capability to perform the additional data acceptance, the electronic rental proposal communication, the electronic rental contract creation and the rental transaction storage regardless of whether the user has a pre-existing master rental agreement with a rental car company that operates the car rental company.

Regarding claims 139, Hertz in view of Avis and HertzGold teaches capability to perform the additional data acceptance, the electronic rental proposal communication, the electronic rental contract creation and the rental transaction storage for a user who does not have a pre-existing master rental agreement with the rental car company.

Claims 67 – 70, 117 – 120 are not patentable under 35 U.S.C. 103(a) over Hertz Corporation hereinafter known as Hertz in view of Avis Rent A Car System, Inc. hereinafter known as Avis and Hertz Announces New, Elite Levels for #1 Club Gold Members in the US – Revamps its #1 Club Membership with Free Upgrade to #1 Club Gold Service hereinafter known as HertzGold and Coutts et al. US Patent 5,389,773 hereinafter known as Coutts.

Regarding claims 67 and 117, Hertz in view of Avis and HertzGold does not explicitly teach capability for automatically pre-filling at least a portion of the additional data into a web page of the website from a rental history associated with the user.

However, Hertz teaches customers can use some or all information contained in customers rental profile. Coutts teaches entering at least some of rental-related information from the history based upon information from an identification of a user without employing a master rental agreement (employs a technique in which aspects of each user's previous behaviour and requirements in self-service transactions are recorded and are then used to predict what that user's probable requirements will be in future transactions).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Hertz in view of Avis as taught by Coutts to increase the speed of operation in carrying out the rental reservation transaction; apply a known technique to a known device (method, or product) ready for improvement to yield predictable results; known work in one field of endeavor may prompt variations of it for use in either the same field or a different one based on design incentives or other market forces if the variations would have been predictable to one of ordinary skill in the art

Regarding claims 68 and 118, Hertz in view of Avis, HertzGold and Coutts teaches capability for:

receiving a selection by the user of a button on the web page that has been configured to solicit the additional data from the user; and

responsive to the button selection, automatically pre-filling at least a portion of the additional data into that web page from the rental history associated with the user.

Regarding claims 69 – 70 and 119 – 120, Hertz in view of Avis and HertzGold teaches capability for automatically performing a suggestive sell for the potential rental through a web page of the website based on a rental history associated with the user wherein the suggestive sell is for an optional coverage item for the potential rental.

(10) Response to Argument

In response to appellant's argument claimed invention is patentable under 35 USC 112, second paragraph.

However, claimed invention is patentable under 35 USC 112, second paragraph because, as claimed in Claim 66, there is a disconnected solicitation for information to the reservation is done via email, and applicant has not positively claimed, how the contract is generated in the same reservation session when the amendments to the reservation are done via email.

In response to appellant's argument cited reference do not teach capability and concept wherein the claimed invention are performed regardless of whether the use has

a pre-existing master rental agreement with a rental car company that operates the rental facility.

However, cited references teach capability and concept of the claimed invention. Also, applicant has not positively claimed to limit the use of invention by only the users who do not have pre-existing master rental agreement.

In response to appellant's argument that cited references do not teach capability and concept for confirming the reservation and generating a contract.

However, as responded to earlier, and how cited reference teaches the claimed invention is explained in the office action mailed 17 March 2011.

In response to appellant's argument that cited references do not teach capability and concept of allowing a user to modify or update their information.

However, it is old and known at time of invention that rental car reservations allowed users to update information, and also, cited references teach capability and concept for allowing users to modified their rental information (see Avis, Page 13).

(11) Related Proceeding(s) Appendix

Copies of the court or Board decision(s) identified in the Related Appeals and Interferences section of this examiner's answer are provided herein.

Decision of Appeal was mailed 20 February 2008. Copy is attached as Exhibit 9 as filed by the appellant on 16 April 2012.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

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